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Attorney Docket No.: BLD920010034US2

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re PATENT APPLICATION Of:

Carl M. Dennison et al.

Appln. No.: 10/065,527

Filed: October 25, 2002

For: VISUAL JOB TICKETING  
USING A DOCUMENT  
VIEWING APPLICATION

Examiner: Peter K. HUNTSINGER

Art Unit: 2624

PRE-APPEAL BRIEF REQUEST FOR REVIEWMail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby request a Pre-Appeal Brief Review in the above identified application. This Request is being filed with a Notice of Appeal, appealing a February 9, 2005, Final Rejection (Final) of the above identified application. Claims 4 and 12 have not yet been substantively rejected and, the Advisory Action (Advisory) indicated that the Amendment After Final (AAF) filed April, 10, 2006, overcame the rejection under 35 U.S.C. §112. The Final is based in part on U.S. Patent No. 6,614,454 to Livingston, which fails to show specifically recited features of claims 1, 3 – 5, 9 and 11 – 13. Therefore, *prima facie* anticipation under 35 U.S.C. §102(e) has not been shown for any of finally rejected claims 1, 3 – 5, 9 and 11 – 13. Neither are these missing elements suggested by Livingston in view of U.S. Patent No. 6,880,124 to Moore to result in claims 2 or 10; in view of published U.S. Patent Application No. 2002/0184305 to Simpson et al. to result in claims 6 – 8 or 14 – 16; in view of U.S. Patent No. 6,268,924 to Koppolu et al. to result in claims 17 or 19, or in view of Simpson et al. in further

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combination with Koppolu et al. to result in claims 18 or 20, all of which depend from claims 1, 3 – 5, 9 and 11 – 13. Therefore, *prima facie* obviousness under 35 U.S.C. §103(a) has not been shown for finally rejected claims 2, 6 – 8, 10 or 14 – 19.

Accordingly, since it has not been shown that any reference of record teaches or suggests the present invention as recited in claims 4 and 12, consideration and reversal of the final rejection and allowance of claims 4 and 12 is respectfully requested.

The present invention includes a method and program product that modify a document for print, providing visual cues to print features selected for printing the document in a modern, high feature printer. Paragraphs 0001 and 0005. In the Amendment filed November 28, 2006, (Amendment) in the bridging paragraph on pages 9 and 10, the appellants noted that Livingston teaches at col. 2, lines 19 – 2, that a “graphical user interface [GUI that] is configured to allow user selection and modification of print engine options for printing the document.” More specifically, one can use the Livingston GUI to configure the printer, selecting print engine options to configure/control the printer, which operates on the printer not the document being printed. Both in the first full paragraph on page 10 of the Amendment and, on page 10, second paragraph of the AAF, the appellants noted differences between Livingston and the present invention as recited in both claim 1 and 9. Specifically, the claims clearly recite “creating an amended document,” (e.g., claim 1 at line 4) not an amended GUI image and, thereafter, the present invention operates on the amended document. Furthermore, the appellants also noted a number of differences between the present invention as claimed and Livingston. However, the appellants specifically pointed out that Livingston fails to teach anything that could be considered “an amended document” (as recited by claims 1 and 9) “consistent with the specification” as §2111 of the MPEP requires. Thus, the appellants averred in the Amendment, that the recited “amended

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document" is quite different than the Livingston image, and the present invention operates quite differently, than the Livingston GUI

In responding to appellants arguments, the Final asserts in the first full paragraph on page 3 that, "[a]ccording to the definition within the art, a document is a writing that contains information. The print preview image is therefore a document. When the print preview image is changed by placing visual cues in the document, an amended document is created. (emphasis added)." There was and is nothing in the record to support the assertion that the "print preview image is ... a document" as the appellants noted in responding to the Final. AF, page 10, first paragraph. The appellants challenged this assertion as not properly noticed as required by §2144.03. *Id.*

Ignoring the challenge to the assertion that a "print preview image is ... a document," the Advisory included a print out from [www.dictionary.com](http://www.dictionary.com) (Definition), provided as evidence that "[t]he definition within the art of document (sic) is a writing that contains information." Appellants note that the Definition specifically recites "d. Computer Science. A piece of work created with an application, as by a word processor. e. Computer Science. A computer file that is not an executable file and contains data for use by applications." Thus, from the record as it currently stands, at least within the broad range of arts encompassed by computer science, a document is a file such as a word processor file. Clearly, from the Definition, the "definition within the art" is not being applied. Therefore, the record fails to support with any evidence, the finding, both that, the "definition within the art ... is a writing that contains information;" and, furthermore, that the "print preview image is ... a document" as §2144.03 requires. Accordingly, *prima facie* anticipation has not been established under 35 U.S.C. §102(e) for any of finally rejected claims 1, 3 – 5, 9 and 11 – 13. Consideration and reversal of the final rejection under 35 U.S.C. §102(e) over Livingston and allowance of claims 1, 3 – 5, 9 and 11 – 13 is respectfully requested.

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Furthermore, because Livingston does not teach inserting visual cues into an original document to create an amended document "consistent with the specification, (*supra*)," and removing the visual cues from the amended document as claims 1 and 9 recite; Livingston fails to perform "the identical function specified in the claim [1 or 9] in substantially the same way, and [fails to produce] substantially the same results." MPEP, §2131. Thus, the appellants have shown that reading of the finally rejected claims on Livingston is inconsistent with the specification and so, the appellants have met their burden in overcoming the allegation equivalency, i.e., that the "print preview image is ... a document." Therefore, since the present invention, as recited in claims 1, 3 - 5, 9 and 11 - 13, is quite different and operates quite differently than the Livingston GUI; Livingston does not teach the present invention or an equivalent thereof, and so, does not anticipate the present invention. Consideration and reversal of the final rejection under 35 U.S.C. §102(e) over Livingston and allowance of claims 1, 3 - 5, 9 and 11 - 13 is respectfully requested.

Regarding the final rejection of claims 2, 6 - 8, 10 and 14 - 20 and under 35 U.S.C. §103(a) over Livingston in view of Moore, Simpson et al., Koppolu et al. and the combination of Simpson et al. and Koppolu et al.; these references fail to supply what was missing from Livingston to result in the present invention. Moore is cited because "Moore discloses automatically saving a document when printing (col. 7, lines 12-18)." This is clearly inconsistent with the allegation that "print preview image is ... a document." How would one save a print preview image? Simpson et al. is cited to "disclose plug-in [sic] to a document editor providing a plug-in interface (page 1, paragraph 3)." Koppolu et al. is cited to teach "a print preview being a thumbnail." As noted in both the Amendment and the AAF, none of these references provides anything to teach or suggest creating an amended document "consistent with the specification, (*supra*)," which was missing from Livingston, to result in the present invention as recited in claims 1, 3 - 5, 9 and 11 - 13, much less claims depending therefrom. Accordingly,

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since dependent claims include all of the differences with the references as the claims from which they depend, Livingston in combination with Moore, Simpson et al., Koppolu et al. alone or in further combination with each other does not result in the present invention as recited in claims 2, 6 - 8, 10 and 14 - 20. Consideration and reversal of the final rejection under 35 U.S.C. §103(a) over Livingston in combination with Moore, Simpson et al., Koppolu et al. alone or in further combination with each other and allowance of claims 2, 6 - 8, 10 and 14 - 20 is respectfully requested.

Independent review, consideration and allowance of all claims is respectfully requested. Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

May 9, 2006  
(Date).

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